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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,593	05/30/2001	John J. Ryan III	274	4947

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 05/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/866,593

Applicant(s)

RYAN ET AL.

Examiner

Naschica S Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

This is the first Office Action for serial number 09/866,593, Insulating Wire Separator Apparatus for Piping Systems, filed on May 30, 2001. Claims 1-20 are pending.

#### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### ***Priority***

If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

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If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

### ***Specification***

The disclosure is objected to because of the following informalities: on page 2, line 21 delete "caused by"; on page 4, line 20, "a" before "insulating" should be --an--; on page 5, line 20, "charge, or caused by" should be --charge

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or--; on page 7, line 4, "about inches to six inches" is confusing, on line 13 insert --of-- before "the opening", on line 21 insert --of-- before "a tracer wire"; on page 9, line 5 "resisting" should be --preventing--; on page 19, line 3, "charge, or caused by" should be --charge or--. Appropriate correction is required.

### ***Claim Objections***

Claims 3 and 11 are objected to because of the following informalities: on line 4 and 2 respectively, delete ", " after "post". Appropriate correction is required.

Claim 9 is objected to because of the following informalities: on line 2 insert --a-- after "having". Appropriate correction is required.

Claim 10 is objected to because of the following informalities: on line 4 insert --portion-- after "said main conduit"; on line 12 insert "at right angles" should be -- at a right angle--. Appropriate correction is required.

Claim 16 is objected to because of the following informalities: on line 2 insert --a-- after "having". Appropriate correction is required.

Claim 17 is objected to because of the following informalities: on line 5 insert --portion-- after "the main conduit"; on line 20 delete ", " after "separator". Appropriate correction is required.

Applicant is advised that should claims 12 and 15 be found allowable, claims 19 and 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight

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difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) *not mentioned in the description*: "Q" in Figure 7A. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they *do not include* the following reference sign(s) mentioned in the description: 2-2 on page 4, line 22; 3-3 on page 5, line 3; 122 on page 7, line 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1, 10, and 17 recite the limitation "the side opposite said opening" in lines 5, 7-8, and 8-9 respectively. There is insufficient antecedent basis for this limitation in the claims.

Regarding claims 16 and 18, line 3 "said first half portion" should be --said first half radiused portion-- for consistency and to provide sufficient antecedent basis for this limitation in the claim.

Regarding claim 16, the word "means" is preceded by the words "releasable securement" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Regarding claim 17, line 20 "said separator" should be --said separator post-- for consistency and to provide sufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,601,260 to Shinohara et al. (Shinohara). With regards to claims 1-3 and 6, Shinohara discloses a wire support (Fig. 2) made of resin comprising: a resilient main conduit receiving portion (41 adjacent 14) having an inner radius and an opening (between 50 and 54A); an I-beam arm portion (extending between 20 and 14) extending beyond the main conduit receiving portion (41 adjacent 14) on the side opposite the opening (between 50 and 54A); a plate portion (46 located between 41 and 52) extending at right angles from the arm portion in proximity to the conduit receiving portion (41 adjacent 14); a wire clip portion (41 adjacent 12) having a pair of fingers (50,52) and positioned at a distal end of the arm portion; and a separator post (30,40) extending at right angles from the arm portion and spaced from the plate portion, the arm portion extending beyond the separator post (30,40). Shinohara does not explicitly teach the arm portion extending at least six inches beyond the main conduit receiving portion. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the arm portion to extend at least six (or ten) inches beyond the main conduit receiving portion as a matter of design choice since the specified length does not produce any unobvious results and it appears the invention would function equally as well. Shinohara does not explicitly teach the wire clip portion (41 adjacent 12) located at least six inches from the centerline of the main conduit receiving portion. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire clip portion



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(41 adjacent 12) to be located at least six inches from the centerline of the main conduit receiving portion as a matter of design choice since the exact location does not produce any unobvious results and it appears the invention would function equally as well. Regarding claim 3, arguably Shinohara teaches the arm portion extending at least two inches beyond the separator post (30). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the arm portion to extend at least two inches beyond the separator post as a matter of design choice since the specified length does not produce any unobvious results and it appears the invention would function equally as well.

Regarding claim 5, Shinohara does not disclose the wire support being color-coded. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire support to be of various colors as a matter of design choice based on aesthetics since the exact color of the wire support does not produce any unobvious results and it appears the invention would function equally as well.

Regarding claims 7 and 8, Shinohara discloses the wire support as applied to claim 1 above, but does not teach the opening (between 50 and 54A) being angled from sixty to eighty degrees or the wire clip finger portion (41 adjacent 12) being angled from three to thirty degrees from the centerline of the arm portion (20). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the opening of the main conduit receiving portion to be angled between sixty and eighty degrees or

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the wire clip finger portion to be angled between three and thirty degrees since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of U.S. Patent 5,772,166 to Adams. With regards to claim 9, Shinohara discloses the wire support as applied to claim 1 above, but does not teach the main conduit receiving portion comprising first and second half radiused portions. Adams discloses a mounting clip comprising a main conduit receiving portion (Fig. 11) including a first half radiused portion (132) releasably fastened to a second half radiused portion (134) by a releasable fastening means (140,142). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the item secured therein as taught by Adams (col. 8, lines 13-20).

Claims 4, 10-15, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of U.S. Patent 5,018,260 to Ziu. With regards to claims 4, 10-15, 17, 19, and 20, Shinohara discloses the wire support as applied to claim 1 above, but does not disclose the main conduit receiving portion including a strengthening rib. Adams discloses a wire clip comprising a main conduit receiving portion (18) including an outer rib (40) extending thereabout. It would have been obvious to one of ordinary skill in the art at the

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time the invention was made to have modified the wire support of Shinohara by including an outer rib because one would have been motivated to provide a stronger gripping support as taught by Ziu (col. 5, lines 56-58).

Regarding claims 10 and 17, Shinohara in view of Ziu does not explicitly teach the wire clip portion (41 adjacent 12) located midway between the separator post (30) and centerline of the main conduit receiving portion. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire clip portion (41 adjacent 12) to be located midway between the separator post and the centerline of the main conduit receiving portion as a matter of design choice since the exact location does not produce any unobvious results and it appears the invention would function equally as well.

Regarding claims 11 and 17, arguably Shinohara in view of Ziu teaches the arm portion extending at least two inches beyond the separator post (30). However, Shinohara in view of Ziu does not explicitly teach the separator post extending two inches from the arm portion or the arm portion extending at least two inches beyond the separator post. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the separator post to extend two inches from the arm portion or the arm portion to extend at least two inches beyond the separator post as a matter of design choice since the specified lengths do not produce any unobvious results and it appears the invention would function equally as well.

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Regarding claims 12 and 20, Shinohara in view of Ziu does not disclose the wire support being color-coded. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire support to be of various colors as a matter of design choice based on aesthetics since the exact color of the wire support does not produce any unobvious results and it appears the invention would function equally as well.

Regarding claims 14 and 17, Shinohara in view of Ziu does not disclose the opening (between 50 and 54A) being angled from sixty to eighty degrees. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the opening to be sized within the specified range as a matter of design choice since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Regarding claims 15 and 19, Shinohara in view of Ziu does not teach the wire clip finger portion (41) being angled from three to thirty degrees from the centerline of the arm portion (20). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to be angled between sixty and eighty degrees or the wire clip finger portion to be angled between three and thirty degrees since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view Ziu as applied above, and further in view of U.S. Patent 5,772,166 to Adams. With regards to claims 16 and 18, Shinohara in view of Ziu discloses the wire support as applied to claims 10 and 17 above, but does not teach the main conduit receiving portion comprising first and second half radiused portions. Adams discloses a mounting clip comprising a main conduit receiving portion (Fig. 11) including a first half radiused portion (132) releasably fastened to a second half radiused portion (134) by a releasable fastening means (140,142). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the item secured therein as taught by Adams (col. 8, lines 13-20).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1537772 to Hitzler; 3385545 to Patton; 3568964 to Perkins;

3884438 to Logsdon; 3907239 to Ehrlich; 4771137 to Thompson;

4819903 to Jimenez; 4890805 to Morita; 5058838 to Velke, Sr. et al;


5577697 to Accordino; 5644106 to Gajeski et al; 6227510 to McMullen Sr.


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The above references disclose support assemblies relevant to Applicant's invention.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine telephone number for the Technology Center is (703) 305-3598 (formal amendments) or (703) 308-3519 (informal communications).

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 308-2168.

  
Naschica S. Morrison  
Patent Examiner  
Art Unit 3632  
**5/18/02**

  
LESLIE A. BRAUN  
SUPERVISORY PATENT EXAMINER